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EXAMINER

MUHEBBULLAH, SAJEDA

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,378

Applicant(s)

SANDSTROM ET AL.

Examiner

Sajeda Muhebbullah

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to Appeal Brief filed 8/10/2005.
2. Claims 1-25 are pending in this application. Claims 1, 12, 18, 22, and 25 are independent claims. This action is made Non-Final.
3. In view of the Appeal Brief filed on 8/10/2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

4. Applicant's arguments, see pages 16-17 and 24-25, filed 8/10/2005, with respect to the rejection(s) of claim(s) 7 and 22 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art reference Borgstrom et al. ("Borgstrom", US 6,738,053).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2174

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 8, 10, 12-13 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Sklarew (US 4,972,496).

As per claim 1, Sklarew teaches a filing appliance comprising means for holding a plurality of sheets (col.3, lines 37-40) wherein at least one input field (Fig.12c) is provided with a position-coding pattern (col.5, lines 61-64) and is adapted to be filled in by a drawing device (col.5, lines 57-60) which records, using said position-coding pattern, positions in the input field in order to digitally (col.7, line 38) record information entered in the input field (col.5, lines 61-67), and an initiation icon is provided (Fig.10, *SAVE*; Fig.12F, *INSERT*), wherein a detection of the initiation icon by the drawing device is adapted to initiate an operation in a computer system communicating with the drawing device, in which operation an information object is created (col.11, lines 41-43; col.12, lines 55-57), which is identifiable at least by means of information entered in the input field.

As per claim 2, Sklarew teaches the input field to be adapted to be filled in at least with text (col.12, lines 28-29).

As per claim 3, Sklarew teaches the input field to be adapted to be filled in at least with an illustration (col.4, lines 33-35).

As per claim 8, Sklarew teaches a filing appliance wherein in at least two sheets in a subset of said plurality of sheets are provided with a position-coding pattern, so that information filled in on a sheet in the subset can be recorded by said drawing device (col.5, lines 61-64) as a digital graphical input (col.7, lines 37-38), and a send icon provided with a position-coding

Art Unit: 2174

pattern (Fig.12F, *INSERT*), a marking of the send icon by means of the drawing device initiating an operation in a computer system (col.12, lines 55-57), in which operation graphical inputs entered on the sheet are transferred to the computer system (col.3, lines 42-45) and optionally on to an external computer system (col.10, lines 53-57).

As per claim 10, Sklarew teaches a filing appliance wherein said information object comprises a file (col.10, lines 23-25; col.12, lines 55-57; *added text inserted into file*).

Independent claim 12 is similar in scope to independent claim 1, and is therefore rejected under similar rationale.

As per claim 13, Sklarew teaches the computer system to be integrated with the drawing device (Fig.2; col.5, lines 59-60).

As per claim 21, Sklarew teaches the filing appliance of claim 1, wherein the initiation icon is provided with a position-coding pattern (Fig.10, *SAVE*; Fig.12F, *INSERT*).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-3, 7-8, 10-15 and 21-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Borgstrom et al. ("Borgstrom", US 6,738,053).

As per claim 1, Borgstrom teaches a filing appliance comprising means for holding a plurality of sheets wherein at least one input field is provided with a position-coding pattern

Art Unit: 2174

(col.3, lines 5-10) and is adapted to be filled in by a drawing device which records, using said position-coding pattern, positions in the input field in order to digitally record information entered in the input field (col.4, lines 28-35), and an initiation icon is provided, wherein a detection of the initiation icon by the drawing device is adapted to initiate an operation in a computer system communicating with the drawing device (col.4, lines 47-49), in which operation an information object is created, which is identifiable at least by means of information entered in the input field (col.7, lines 60-63).

As per claim 2, Borgstrom teaches the input field to be adapted to be filled in at least with text (col.4, lines 20-22).

As per claim 3, Borgstrom teaches the input field to be adapted to be filled in at least with an illustration (col.4, lines 20-22).

As per claim 7, Borgstrom teaches a filing appliance which comprises an address field provided with a position-coding pattern, and an order icon, a marking of the order icon by said drawing device being adapted to initiate an operation in the computer system, which operation performs an order of another filing appliance to be delivered to the address entered in the address field. (col.7, lines 25-35, 53-56).

As per claim 8, Borgstrom teaches a filing appliance wherein in at least two sheets in a subset of said plurality of sheets are provided with a position-coding pattern, so that information filled in on a sheet in the subset can be recorded by said drawing device as a digital graphical input (col.7, lines 7-8), and a send icon provided with a position-coding pattern (col.6, lines 8-9), a marking of the send icon by means of the drawing device initiating an operation in a computer

Art Unit: 2174

system, in which operation graphical inputs entered on the sheet are transferred to the computer system and optionally on to an external computer system (col.4, lines 50-67).

As per claim 10, Borgstrom teaches a filing appliance wherein said information object comprises a file (col.7, lines 58-61; *email file*).

As per claim 11, Borgstrom teaches a filing appliance comprising an archiving icon, detection of the archiving icon by the drawing device being adapted to initiate an operation wherein position information corresponding to strokes of the drawing device, which strokes are generated after a reference time point, is transmitted from the drawing device to the computer system (col.4, lines 47-49).

Independent claims 12 and 22 are individually similar in scope to independent claim 1, and are therefore rejected under similar rationale.

As per claim 13, Borgstrom teaches the computer system to be integrated with the drawing device (col.9, lines 5-9).

Claims 14 and 24 are similar in scope to claim 11, and are therefore rejected under similar rationale.

As per claim 15, Borgstrom teaches the system wherein the reference time point is set to the current time in connection with the transmission of the position information (col.10, lines 30-35).

As per claim 21, Borgstrom teaches the filing appliance of claim 1, wherein the initiation icon is provided with a position-coding pattern (col.7, lines 31-37).

As per claim 23, Borgstrom teaches the filing device wherein the information object electronically represents the filing device (col.7, lines 44-47).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) in view of Gough et al. ("Gough", US 5,603,053).

As per claims 4-5, Sklarew teaches a filing appliance wherein in at least a subset of said plurality of sheets are provided with a position-coding pattern so that information filled in on a sheet in the subset by said drawing device (col.5, lines 61-64) is recordable as a digital graphical input (col.7, lines 37-38), the filing appliance comprising a number of icons (Fig.10). However, Sklarew does not disclose the filing appliance to comprise of a number of appearance icons, a marking of an appearance icon by means of said drawing device being adapted to give the digital graphical input a visual property. Gough teaches an appliance to be input by a drawing device wherein the appliance comprises a number of appearance icons (Fig.2b, *icons 42, 44, 46*) which when marked provide the input a visual property relating to stroke weight (col.6, lines 23-28). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Gough with Sklarew in order visually enhance the input of the user.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) and Gough et al. ("Gough", US 5,603,053) in view of Microsoft PowerPoint ("PowerPoint").

As per claim 6, Sklarew and Gough teach the drawing device to give the digital input a visual property but does not disclose the visual property to relate to line color. However, PowerPoint teaches a drawing device adapted to give the input a line color (page 2, line color icon). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of PowerPoint with the teaching of Sklarew and Gough in order to visually enhance the input of the user.

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) in view of Wildermuth (US 5,950,188).

As per claim 9, Sklarew teaches a filing appliance wherein said information object comprises a database (col.11, line 58; *character object added to database*). However, Sklarew does not explicitly disclose the database to be in the form of a table. Wildermuth teaches a computer system wherein a table in a database stores and retrieves information (col.5, lines 41-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Wildermuth's teaching with Sklarew appliance to increase the flexibility of modifying the data and make the database more user-friendly (Wildermuth, col.5, lines 55-58).

13. Claims 11, 14-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) in view of Lamming (US 5,535,063).

As per claims 14-15 and 17, Sklarew teaches a filing appliance comprising an archiving icon (Fig.10, *SAVE*), a detection of the archiving icon by the drawing device initiates an operation wherein position information corresponding to strokes of the drawing device is transmitted from the drawing device to the computer system (col.5, lines 61-64; abstract, lines 6-8). However, Sklarew does not explicitly disclose the position information to be of strokes

Art Unit: 2174

generated after a reference time point which is to be set to the current time in connection with the transmission of the position information and stored in the computer system. Lamming teaches a system of time-stamping strokes entered by a drawing device which are then stored in the computer system (col.2, lines 8-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Lamming's teaching with Sklarew's system in order to provide a fast and efficient method of locating previously stored information.

Claim 11 is similar in scope to claim 14, and is therefore rejected under similar rationale.

14. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) and Lamming (US 5,535,063) in view of Morishita et al. ("Morishita", US 6,335,727).

As per claim 16, the system of Sklarew and Lamming teaches the reference time point to be stored in the computer system, however, does not teach the reference time point to be stored in the drawing device. Morishita teaches a drawing device with the ability to store time points (col.13, lines 34-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Morishita's teaching with the system of Sklarew and Lamming in order to provide increased portability of positional information.

15. Claims 18-20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) and Eichstaedt et al. ("Eichstaedt", US 6,563,494).

As per claim 18, Sklarew teaches a method for processing information comprising:

receiving position information from a drawing device, the position information being generated when the drawing device is moved over a position-coding pattern (col.5, lines 61-67), the position information including information that is generated before and after time point t

Art Unit: 2174

(time is continuous therefore inherent for a time to exist in which the position information is generated);

However, Sklarew does not disclose inserting buffered position information generated before said time point t in a first information object wherein the first information object is related to a first filing appliance and inserting position information generated after said time point t in a second information object, wherein the second information object is related to a second filing appliance. Eichstaedt teaches a method of having multiple buffered position information generated before and after a time to be inserted into separate objects (Eichstaedt, col.5, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Eichstaedt's teaching with Sklarew's method in order to use the drawing device for multiple applications.

Claims 19-20 and 25 are individually similar in scope to claim 18, and are therefore rejected under similar rationale.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgstrom et al. ("Borgstrom", US 6,738,053) in view of Gough et al. ("Gough", US 5,603,053).

As per claims 4-5, Borgstrom teaches a filing appliance wherein in at least a subset of said plurality of sheets are provided with a position-coding pattern so that information filled in

Art Unit: 2174

on a sheet in the subset by said drawing device is recordable as a digital graphical input (col.7, lines 7-8), the filing appliance comprising a number of icons (col.7, lines 30-33; col.8, lines 15-18). However, Borgstrom does not disclose the filing appliance to comprise of a number of appearance icons, a marking of an appearance icon by means of said drawing device being adapted to give the digital graphical input a visual property relating to stroke weight. Gough teaches an appliance to be input by a drawing device wherein the appliance comprises a number of appearance icons (Fig.2b, *icons 42, 44, 46*) which when marked provide the input a visual property relating to stroke weight (col.6, lines 23-28). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Gough with Borgstrom in order visually enhance the input of the user.

18. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borgstrom et al. ("Borgstrom", US 6,738,053) and Gough et al. ("Gough", US 5,603,053) in view of Microsoft PowerPoint ("PowerPoint").

As per claim 6, Borgstrom and Gough teach the drawing device to give the digital input a visual property but does not disclose the visual property to relate to line color. However, PowerPoint teaches a drawing device adapted to give the input a line color (page 2, line color icon). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of PowerPoint with the teaching of Borgstrom and Gough in order to visually enhance the input of the user.

19. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borgstrom et al. ("Borgstrom", US 6,738,053) in view of Wildermuth (US 5,950,188).

As per claim 9, Borgstrom teaches a filing appliance wherein said information object comprises a file in a database (col.6, line 43). However, Borgstrom does not explicitly disclose a table in the database. Wildermuth teaches a computer system wherein a table in a database stores and retrieves information (col.5, lines 41-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Wildermuth's teaching with Borgstrom appliance to increase the flexibility of modifying the data and make the database more user-friendly (Wildermuth, col.5, lines 55-58).

20. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borgstrom et al. ("Borgstrom", US 6,738,053) in view of Morishita et al. ("Morishita", US 6,335,727).

As per claim 16, Borgstrom teaches the reference time point to be set to the current time (col.10, lines 30-35), however, does not teach the reference time point to be stored in the drawing device. Morishita teaches a drawing device with the ability to store time points (col.13, lines 34-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Morishita's teaching with Borgstrom's system in order to provide increased portability of positional information.

21. Claim 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgstrom et al. ("Borgstrom", US 6,738,053) in view of Lamming (US 5,535,063).

As per claim 17, Borgstrom teaches wherein the reference time point is to be set to the current time in connection with the transmission of the position information. However, Borgstrom does not explicitly disclose storing the time point in the computer system. Lamming teaches a system of time-stamping strokes entered by a drawing device which are then stored in the computer system (col.2, lines 8-20). It would have been obvious to one of ordinary skill in

Art Unit: 2174

the art at the time of the invention to include Lamming's teaching with Borgstrom's system in order to provide a fast and efficient method of locating previously stored information.

22. Claims 18-20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgstrom et al. ("Borgstrom", US 6,738,053) and Eichstaedt et al. ("Eichstaedt", US 6,563,494).

As per claim 18, Borgstrom teaches a method for processing information comprising:
receiving buffered position information from a drawing device, the position information being generated when the drawing device is moved over a position-coding pattern, the position information including information that is generated before and after time point t (col.13, lines 14-19; *time is continuous therefore inherent for a time to exist in which the position information is generated*);

However, Borgstrom does not disclose inserting position information generated before said time point t in a first information object wherein the first information object is related to a first filing appliance and inserting position information generated after said time point t in a second information object, wherein the second information object is related to a second filing appliance. Eichstaedt teaches a method of having multiple buffered position information generated before and after a time to be inserted into separate objects (Eichstaedt, col.5, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Eichstaedt's teaching with Borgstrom's method in order to use the drawing device for multiple applications.

Claims 19-20 and 25 are individually similar in scope to claim 18, and are therefore rejected under similar rationale.

Response to Arguments

23. Applicant's arguments with respect to claims 1-6, 8-21 and 25 have been fully considered but they are not persuasive.

Applicant argued the following:

a) Sklarew fails to teach a filing appliance comprising means for holding a plurality of sheets.

b) No teaching in Sklarew directed to a position-coding pattern. No teaching in Sklarew of a drawing device which records, using the position-coding pattern positions to digitally record information entered in the input field.

c) Sklarew does not teach a filing appliance, drawing device, and computer system.

d) No teaching in Lamming directed to wherein position information corresponding to strokes of the drawing device, which strokes are generated after a reference time point, is transmitted from the drawing device to the computer system. No teaching of detection of an archiving icon.

e) Eichstaedt does not teach inserting position information generated before said time point in a first information object wherein the first information object is related to a first filing appliance; and inserting position information generated after said time point in a second information object, wherein the second information object is related to a second filing appliance.

The Examiner disagrees for the following reasons:

Per a), Sklarew teaches the holding of sheets in memory as cited previously in col.3, lines 37-40.

Art Unit: 2174

Per b), Sklarew clearly teaches using a coordinate of positions or a pattern of positions to record positions in the input field which is recorded by a stylus that transmits these positions once it has received the corresponding positions (col.5, lines 60-64)

Per c), Sklarew teaches all three items as seen in Fig.1 depicting a filing appliance (Fig.1, 12) comprising of a drawing device (Fig.1, stylus 16) and a computer system (Fig.1, microcomputer 14).

Per d), In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Per e), Eichstaedt teaches the additional limitation cited above of the inserting of information regarding a position into two separate appliances thru the actions of the user (col.5, lines 20-27).

Art Unit: 2174

Communications

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sajeda Muhebbullah whose telephone number is (571) 272-4065. The examiner can normally be reached on Tuesday/Thursday and alt. Mondays from 8:00 am to 4:30 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (571) 272-4063.

The central fax number for the organization where correspondence for this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sajeda Muhebbullah
Patent Examiner
Art Unit 2174

Kristine Kincaid
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